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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,240	04/06/2004	Robert Greenberg	S293-USA	7467
28284	7590	07/06/2006		EXAMINER
				REIDEL, JESSICA L
			ART UNIT	PAPER NUMBER
				3766

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/820,240	GREENBERG ET AL.	
	Examiner	Art Unit	
	Jessica L. Reidel	3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 19 April 2006.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,4,5,9,10,13-16,35,36,39-42,44 and 45 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 41,42,44 and 45 is/are allowed.
 6) Claim(s) 1,4,5,9,13,14,16,35,39 and 40 is/are rejected.
 7) Claim(s) 10,15 and 36 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 06 April 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 02/06, 04/06.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

1. Acknowledgment is made of Applicant's Amendment, which was received by the Office on April 19, 2006. Claims 36-45 are new and active, however, after the Examiner initiated telephonic interview conducted with Scott Dunbar on June 23, 2006, Claims 2-3, 6-8, 11-12, 17-34, 37-38 and 43 have been cancelled to expedite prosecution of the current application. Claims 1, 4-5, 9-10, 13-16, 35-36, 39-42 and 44-45 are pending.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on April 19, 2006 has been acknowledged and is being considered by the Examiner.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "folded cable" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 4-5 are objected to because of the following informalities: there appears to be typographical error in the third lines of the claims. The Examiner suggests revising the limitation of "a sclera" to read "the sclera". Appropriate correction is required.
5. Claim 13 is objected to because of the following informalities: there appears to be a typographical error in the second line of the claim. The Examiner suggests revising the second line to read, "suitable to be placed in an epiretinal location". Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 39 is rejected under 35 U.S.C. 102(e) as being anticipated by Nisch et al. (U.S. 6,847,847) (herein Nisch). Nisch discloses a retinal prosthesis 30 comprising an electrode array 36 suitable to be mounted in close proximity to a retina (see Nisch column 1, lines 34-36 and Figs. 1 and 2) and an electronics package 35 (see Nisch column 6, lines 49-55). The retinal

prostheses further comprises an electrical cable 41 coupling the electrode array 36 to the electronics package 35 (see Nisch column 7, lines 1-2) and a secondary “receiver” coil 37, electrically coupled to the electronics package 35 (see Nisch Fig. 2) and suitable to be mounted to the side of the sclera (see Nisch Fig. 1). Nisch further discloses that the retinal prosthesis 30 further comprises an annular area, read as a hook 32 suitable for engaging a surgical tool (see Nisch Fig. 1).

8. Claims 1, 13-14, 16, 35 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Williamson et al. (U.S. 6,718,209) (herein Williamson). The applied reference has a common Inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

As to Claim 1, Williamson expressly discloses a retinal prosthesis comprising an electrode array 10 suitable to be mounted in close proximity to a retina, an electronic control unit, read as an electronics package 18, an electrical cable 14 coupling the electrode array 10 to the electronics package 18 where the cable 14 is suitable to pierce the pars plana region of the sclera 16 (see Williamson Abstract, Fig. 1 and column 2, lines 34-37). Williamson further discloses that the prosthesis comprises a secondary inductive coil 22 mounted around the front of the sclera 16, electrically coupled to the electronics package 18. It has been held that the recitation that an element is “adapted to”, “capable of” or “suitable to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation

in any patentable sense. *In re Hutchison*, 69 USPQ 138. The Examiner takes the position that the coil 22 of Williamson can be mounted on the front, back and either side of the sclera 16 (see Williamson Fig. 1 and column 3, lines 5-9).

9. As to Claim 13, Williamson expressly discloses that the electrode array 10 is suitable to be placed in an epiretinal location (see Williamson column 2, line 36).

10. As to Claims 14, 16 and 40, Williamson depicts in Fig. 1 that the secondary inductive coil 22 is a wound wire coil that is substantially oval shaped (see Williamson Fig. 1).

11. As to Claim 35, Williamson discloses the claimed invention as discussed above. Williamson expressly discloses that the prosthesis comprises a secondary inductive coil 22 mounted around the front of the sclera 16, electrically coupled to the electronics package 18. It has been held that the recitation that an element is “adapted to”, “capable of” or “suitable to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. The Examiner takes the position that the coil 22 of Williamson can be mounted to the side of a skull outside the orbit of the eye.

12. Claims 1, 9, 13-14, 16, 35 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Greenberg et al. (U.S. 2003/0233133) (herein Greenberg ‘133). The applied reference has a common Inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this

application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

As to Claim 1, Greenberg ‘133 expressly discloses a retinal prosthesis comprising an electrode array 10 suitable to be mounted in close proximity to a retina 14, an electronics control unit, read as an electronics package 20, a flexible circuit ribbon, read as an electrical cable 24 coupling the electrode array 10 to the electronics package 20 suitable to pierce the plans plana region of the sclera 16 (see Greenberg ‘133 Abstract, Fig. 1 and page 3, paragraph 34). Greenberg ‘133 further discloses that the prosthesis comprises a secondary inductive coil 28 located outside the eye 2, near the lens 4 (see Greenberg ‘133 page 3, paragraph 34). It has been held that the recitation that an element is “adapted to”, “capable of” or “suitable to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. The Examiner takes the position that the coil 28 of Greenberg ‘133 can be mounted on the front, back and either side of the sclera 16 (see Greenberg ‘133 Fig. 1 and page 3, paragraph 34).

13. As to Claim 9, Greenberg ‘133 discloses that the cable 24 and the electrode array 10 comprise metal traces sandwiched between thin polymer films (see Greenberg ‘133 Fig. 4 and page 3, paragraph 37).

14. As to Claim 13, Greenberg ‘133 discloses that the electrode array 10 is in contact with the retina 14, which is synonymous with “epiretinally” (see Greenberg ‘133 page 3, paragraph 34).

15. As to Claims 14, 16 and 40, Greenberg ‘133 depicts in Fig. 1 that the secondary inductive coil 28 is a wound wire coil that is substantially oval shaped (see Greenberg ‘133 Fig. 1).

16. As to Claim 35, Greenberg '133 discloses the claimed invention as discussed above. Greenberg '133 expressly discloses that the prosthesis comprises a secondary inductive coil 28 located outside the eye 2, near the lens 4, electrically coupled to the electronics package 20 by wire 30. It has been held that the recitation that an element is "adapted to", "capable of" or "suitable to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. The Examiner takes the position that the coil 28 of Greenberg '133 can be mounted to the side of a skull outside the orbit of the eye.

17. Claims 1, 9, 13-14, 16, 35 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Greenberg et al. (U.S. 2003/0233134) (herein Greenberg '134). The applied reference has a common Inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As to Claim 1, Greenberg '134 expressly discloses a retinal prosthesis comprising an electrode array 10 suitable to be mounted in close proximity to a retina 14, an electronics control unit, read as an electronics package 20 and a flexible circuit ribbon, read as an electrical cable 24 coupling the electrode array 10 to the electronics package 20 suitable to pierce the pars plana region of the sclera 16 (see Greenberg '134 Abstract, Fig. 1 and page 3, paragraphs 45-46). Greenberg '134 further discloses that the prosthesis comprises a secondary inductive coil 28

located outside the eye 2, near the lens 4 (see Greenberg '134 Fig. 1 and page 3, paragraph 46). It has been held that the recitation that an element is "adapted to", "capable of" or "suitable to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. The Examiner takes the position that the coil 28 of Greenberg '134 can be mounted on the front, back and either side of the sclera 16 (see Greenberg '134 Fig. 1 and page 3, paragraph 46).

18. As to Claim 9, Greenberg '134 discloses that the cable 24 and the electrode array 10 comprise metal traces sandwiched between thin polymer films (see Greenberg '134 Fig. 4 and page 3, paragraphs 48-50).

19. As to Claim 13, Greenberg '134 discloses that the electrode array 10 is in contact with the retina 14, which is synonymous with "epiretinally" (see Greenberg '134 page 3, paragraph 45).

20. As to Claims 14, 16 and 40, Greenberg '134 depicts in Fig. 1 that the secondary inductive coil 28 is a wound wire coil that is substantially oval shaped (see Greenberg '134 Fig. 1).

21. As to Claim 35, Greenberg '134 discloses the claimed invention as discussed above. Greenberg '134 expressly discloses that the prosthesis comprises a secondary inductive coil 28 located outside the eye 2, near the lens 4, electrically coupled to the electronics package 20 by wire 30. It has been held that the recitation that an element is "adapted to", "capable of" or "suitable to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. The Examiner takes the position that the coil 28 of Greenberg '134 can be mounted to the side of a skull outside the orbit of the eye.

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 40 is rejected under 35 U.S.C. 103(a) as being obvious over Nisch. Nisch discloses the claimed invention as discussed above except that it is not specified that the coil be substantially oval shaped. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the coil as taught by Nisch with an oval coil, because Applicant has not disclosed that an oval coil provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the round coil as taught by Nisch, because it provides adequate means for receiving RF energy and since it appears to be an arbitrary design consideration which fails to patentably distinguish over Nisch.

Therefore, it would have been an obvious matter of design choice to modify Nisch to obtain the invention as specified in the claim.

24. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being obvious over Williamson in view of Nisch. The applied reference has a common Inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a

showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

25. As to Claim 4, Applicant differs from Williamson in that the prosthesis comprises suture tabs connected to the secondary inductive coil suitable for attaching the coil to the sclera. The Examiner considers the use of suture tabs to connect a coil of a retinal prosthesis to the sclera to be conventional and well known in the art with Nisch being but one example (see Nisch Fig. 2 and columns 6-7).

26. As to Claim 5, Applicant differs from Williamson in that the prosthesis comprises suture tabs connected to the electronics package suitable for attaching the coil to the sclera. The Examiner considers the use of suture tabs to connect the electronics of a retinal prosthesis to the sclera to be conventional and well known in the art with Nisch being but one example (see Nisch Fig. 2 and columns 6-7).

Double Patenting

27. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible

harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

28. Claims 1, 4-5, 13-14, 16 and 40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 6,718,209 in view of Nisch. Although the conflicting claims are not identical, they are not patentably distinct each other because the current claims are either an obvious broadening of the scope of the claims of Patent No. 6,718,209 or an obvious variant thereof. Specifically, Patent No. 6,718,209 claims

the same invention as the current Application except the prosthesis is not specified to comprise a secondary inductive coil mounted to the side of the sclera and it is also not specified that the prosthesis comprise suture tabs. Nisch, however, discloses a retinal prosthesis 30 comprising an electrode array 36 suitable to be mounted in close proximity to a retina (see Nisch column 1, lines 34-36 and Figs. 1 and 2) and an electronics package 35 (see Nisch column 6, lines 49-55). The retinal prostheses of Nisch further comprises an electrical cable 41 coupling the electrode array 36 to the electronics package 35 (see Nisch column 7, lines 1-2) and a secondary “receiver” coil 37, electrically coupled to the electronics package 35 (see Nisch Fig. 2) and suitable to be mounted to the side of the sclera (see Nisch Fig. 1) so that the prosthesis may receive RF energy encoded visual information from outside the skin of the patient. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the claims of Patent No. 6,718,209 to include a secondary inductive coil in order to enable the prosthesis to receive visual information from outside the skin of the patient. Applicant differs from Patent No. 6,718,209 in that the prosthesis comprises suture tabs connected to the electronics package suitable for attaching the coil to the sclera. The Examiner considers the use of suture tabs to connect the electronics of a retinal prosthesis to the sclera to be conventional and well known in the art with Nisch being but one example (see Nisch Fig. 2 and columns 6-7). Applicant differs from Patent No. 6,718,209 in that the prosthesis comprises suture tabs connected to the secondary inductive coil suitable for attaching the coil to the sclera. The Examiner considers the use of suture tabs to connect a coil of a retinal prosthesis to the sclera to be conventional and well known in the art with Nisch being but one example (see Nisch Fig. 2 and columns 6-7).

Allowable Subject Matter

29. Claims 41-42 and 44-45 are allowed.
30. Claims 10, 15 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

31. Applicant's arguments with respect to claims 1, 4-5, 9, 13-14, 16, 35, and 40 have been considered but are moot in view of the new ground(s) of rejection.
32. Applicant's arguments with respect to Claim 39, filed April 19, 2006 have been fully considered but they are not persuasive. Nisch further discloses that the retinal prosthesis 30 further comprises an annular area, read as a hook 32 suitable for engaging a surgical tool (see Nisch Fig. 1). The Examiner defines "hook" to be anything "annular" or "curved", thus the annular area of Nisch is synonymous with a "hook". It is well known that hooks come in many shapes such as squares, S-shapes, ovals etc.

Conclusion

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica L. Reidel whose telephone number is (571) 272-2129. The examiner can normally be reached on Mon-Thurs 8:00-5:30, every other Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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